

REMARKS

A non-final office action, which was mailed October 2, 2006, objected to claims 1, 5, 8 and 16-18, and rejected all pending claims 1-18. An Interview with Examiner Hwang was held on December 27, 2006. In this Amendment in Reply, Applicants amend claims 1, 5, 8, and 16-18. As such, claims 1-18 remain pending. In light of the understandings reached during the interview summarized below, Applicants respectfully request the Examiner's reconsideration of the pending claims in view of the amendments and arguments set forth in this response.

INTERVIEW SUMMARY

The undersigned thanks Examiner Hwang for the courtesies extended during the telephonic interview on December 27, 2006. During the Interview, Agreement was reached as to the differences between the subject matter of Applicants' claims (as currently amended) and U.S. Publ. Pat. Appl. 2004/0083191 to Ronnewinkel et al. Such differences include, for example, using the same categorization scheme to select categories for use in different business process steps.

Agreement was also reached regarding language to overcome the subject matter rejections under 35 U.S.C. § 101. In particular, agreement was reached that, in the context of Applicants' claims, a tangible final result could be found in a step of retrieving response information from a data storage element. In this Amendment in Reply, Applicants amend independent claims 1 and 16 in a way believed to be in accordance with what the Examiner indicated would overcome the subject matter rejections.

Applicants thank the Examiner for taking the time to interview this case.

CLAIM OBJECTIONS: CLAIMS 1, 5, 8, AND 16-18

The office action objected to claims 1, 5, 8, and 16-18 for informalities. Applicants have corrected these claims to improve grammar and/or clarity of the claims. In particular, Applicants amend claims 1 and 16 to further clarify that categories are selected. Applicants provide correct antecedent basis by amending claim 5 to depend from claim 2 instead of claim 1. Claim 8 is

amended to clarify the meaning of “is that,” and claim 17 is amended to clarify “the content of which.” Claim 18 has been corrected to recite “the email editor and the ERMS,” as suggested by the Examiner. Each of these amendments is of a grammatical nature, or corrects a typographical error. No new matter is introduced by these amendments. Applicants request that the Examiner remove these objections.

FURTHER CLAIM AMENDMENTS: CLAIMS 1, 16, AND 17

Applicants make further clarifying amendments to independent claims 1 and 16 in accordance with understandings reached with Examiner Hwang during the Interview. As amended, claims 1 and 16 recite execution of first or second computer-executable response modules, respectively, to perform first and second business process steps. Applicants further amend claims 1 and 16 to clarify that the first and second business process steps use response information linked to categories that are selected from the same categorization scheme. The amended claims also recite that the first and second business process steps are different steps of a business process. Furthermore, the amended claims recite executing the modules by retrieving, from electronic data storage, parts of the response information that are linked to the selected category. These amendments find support throughout the originally filed claims, figures, and specification. For example, support for these amendments may be found at least in Figures 2B-6, and in the specification at paragraphs at [0040, 0055-0059, 0109-112]. As such, these amendments introduce no new matter.

Applicants also amend claim 17 to clarify that “ERMS” refers to “e-mail response management system.” This amendment finds support, for example, in the specification at paragraph [0002]. As such, this amendment does not introduce new matter.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101: CLAIMS 1, 5-17

The office action rejected claims 1 and 5-17 as being directed to non-statutory subject matter under 35 U.S.C. § 101. Applicants respectfully submit that all claims, including 1 and 5-17, have features that establish “useful, concrete, and tangible” final results.

In accordance with the Examiner's suggestions during the interview, Applicants amend the preamble and body of claim 1 to clarify that the method produces concrete, tangible, and useful results. In particular, tangible results of claim 1 include response information that has been retrieved from electronic data storage. The retrieved response information is useful, for example, if included in a response message, or if sent for display on a display device as a suggestion to a user. (See, e.g., specification at paragraphs [0009-0015].) As such, claim 1 is directed to statutory subject matter, as are claims 5-15, each of which depends, either directly or indirectly, from claim 1.

Applicants have amended independent claim 16, in accordance with the Examiner's suggestion, to recite "storage device" instead of "information carrier." As pointed out by the Examiner, support for this amendment can be found in the specification at least at pages 40-41.

As to claims independent claim 17, Applicants submit that the office action does not appear to set forth a basis for rejecting claim 17, and further submit that claim 17 contains statutory subject matter. For example, the method of claim 17 recites responding to receiving an email by "suggesting at least one business object linked to the selected category." Applicants submit that by producing such a suggestion, the method of claim 17 produces a concrete, tangible, and useful result. Accordingly, claim 17 contains statutory subject matter.

Although Applicants have amended certain claims to advance prosecution, Applicants believe that, before amendment, such claims contained patentable subject matter. As such, Applicants reserve the right to pursue claims of the same or similar scope in the future. In accordance with the foregoing amendments and remarks, Applicants request that the rejections under 35 U.S.C. § 101 be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §§ 102(E)/103: CLAIMS 1-18

The office action rejected claims 1-12 and 14-18 as anticipated under 35 U.S.C. § 102(e) by U.S. Publ. Pat. Appl. 2004/0122799 to Ronnewinkel et al. ("the Ronnewinkel reference"). In addition, the office action rejected claim 13 as being under 35 U.S.C. § 103(a) over the

Ronnewinkel reference in view of U.S. Pat. 5,793,861 to Haigh ("the Haigh reference"). Claims 1, 16, and 17 are independent.

Independent claims 1, 16, and 17 (as amended) are each believed to be patentable over the cited reference because the references, either or alone or in combination, do not teach or suggest all elements recited in any of Applicants' claims.

For example, and as discussed during the Interview, the cited references do not teach or suggest a categorization scheme with categories linked to businesses objects that are retrievable to perform different business process steps, as required by Applicants claims 1 and 16. Nor do the cited references teach or suggest a step of suggesting at least one business object linked to a category selected from among multiple categories in a categorization scheme, as required by claim 17.

For at least these reasons, the cited references neither anticipate nor render obvious any of Applicants' independent claims 1, 16, or 17. As such, amended claims 1, 16, and 17 are patentable over the cited references, as are claims 2-15 and 18, each of which depends, either directly or indirectly, from claims 1 or 17. Accordingly, Applicants request that the rejections under 35 U.S.C. §§ 102(e) and 103(a) of claims 1-18 be withdrawn.

CONCLUSIONS

Accordingly, each of the pending claims 1-18 (as amended) defines subject matter that is patentable over the cited prior art. Furthermore, each of the pending claims is believed to be in form for allowance. As such, Applicants request that the Examiner allow all pending claims 1-18.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this

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paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Although no fees are believed to be owed, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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